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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/839,893 | 04/20/2001 | Tony Valenzuela | PALM-3624 | 4291 |

7590 11/06/2002
WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

EXAMINER

LE, UYEN CHAU N

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2876

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,893

Applicant(s)

VALENZUELA ET AL.

Examiner

Uyen-Chau N. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by DeFrasne et al (US 5,603,629).

Re claims 1-8 and 9-12: DeFrasne et al discloses an apparatus for holding a SIM card 70 for an electronic device comprising a SIM card 70; a printed circuit board 20; a SIM connector 15 mounted on the printed circuit board 20; a SIM card door 22 for releasably holding the SIM card 70, the SIM card door 22 is configured to move the SIM card 70 into engagement with the SIM connector 15 when in a closed position, to releasably hold the SIM card 70 such that the SIM card 70 is properly aligned with the SIM connector 15 when the SIM card door 22 is moved into the closed position, to slidably [slide tracks 4] accept the SIM card 70 into a properly aligned position when the SIM card door 22 is in the open position; a plurality of groves [44, 50], which serves as holders disposed on the surface of the SIM card door 22, the groves/holders [44, 50] configured to hold the SIM card 70 in the proper position, to hold the SIM card 70 when the SIM card door 22 is in the open position; the SIM card door 22 is releasably engageable with a housing and is including a latch in order to maintain the closed position and the housing is for containing an electronic device (e.g., a personal information device) (see figs. 1 and 3a; col. 2, line 15 through col. 44).

Art Unit: 2876

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 6, 13-14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Tu (US 6,424,118).

Re claims 6, 13-14 and 16: Tu discloses a SIM card door apparatus for holding a SIM card 12 for an electronic device comprising, a printed circuit board; a device housing containing the printed circuit board; a SIM card door rotatably attached to the device housing, the SIM card door configured to releasably hold the SIM card 12; a SIM card connector mounted on the printed circuit board, the SIM connector configured to electrically connect a SIM card to the printed circuit board when the SIM card door swings the SIM card into engagement with the SIM connector by rotating into a closed position, wherein the electronic device is a cellular telephone 19 and the SIM card door is rotatably attached to a back case of the device housing (figs. 4-5).

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tu. The teachings of Tu have been discussed above.

Re claim 15, Tu has been discussed above but fails to teach or fairly suggest the electronic device is a pager.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the mobile phone as taught by Tu as a pager. Such modification would have mere been a substitution of equivalents well within the ordinary skill in the art for receiving messages, and therefore an obvious expedient.

Art Unit: 2876

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Luvini et al (US 6,193,557); Schnell et al (US 6,234,810); Simmel et al (US 6,220,882); Haffenden et al (US 6,226,189); Kuwata et al (US 5,813,878); Martucci (US 6,174,188); Michaelis et al (US 6,106,317); Kuwata (US 5,984,707); Ito et al (US 6,210,193); Kobayashi (US 5,436,969); An (US 6,179,649); Shibata (JP 08,329,203); Manzaki (JP 2002,101,170) and Reichardt et al (DE 4,080,655) are cited as of interest and illustrate a similar structure to an integrated SIM holder with back-case and rotating door.

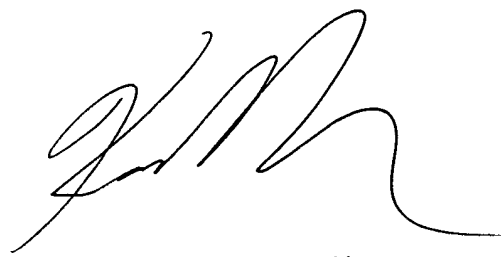
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M, W, F, SAT 6:00-11:00 and T, TH 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Uyen-Chau N. Le

November 4, 2002



KARL D. FRECH
PRIMARY EXAMINER